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IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No. 545

DAYLESS MANUFACTURING COMPANY, INC.
and LESLIE HOFFMAN,

Petitioners,

VS.

ARTMOORE COMPANY
and NILES METALCRAFT COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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with in accordance with Rule 38 of the Rules of this Court. The decision of the Court of Appeals appears in the record at page 379.* The opinion of the Trial Court appears in the record at page 316 and is reported in 109 F. Supp. 181. 96 U.S.P.Q. 254.

A.

Summary and Short Statement.

1. Respondents Artmoore Company and Niles Metalcraft Company filed suit against Petitioners Dayless Manufacturing Company, Inc. and Leslie Hoffman for infringement of claims 7 and 10 of the Rogers Patent No. 2,108,727 issued February 15, 1938, on a mop.

2. On December 31, 1952 (R. 325) the District Court filed its Findings of Fact and Conclusions of Law holding claims 7 and 10 in issue valid and infringed, and that petitioners were guilty of wanton and wilful infringement. On the same day the District Court entered judgment (R. 332) in favor of respondents.

3. By its judgment (R. 388) dated November 6, 1953, the Court of Appeals for the Seventh Circuit in this case affirmed the portion of the judgment adjudicating the validity and infringement of claims 7 and 10 of Rogers Patent No. 2,108,727 in suit and reversed the portion of the judgment adjudicating wilful and wanton infringement.

4. The patent in suit by its specification (R. 304-305) and drawings (R. 303) discloses, and claims 7 and 10 define, a combination comprising a number of individual elements combined to afford a self wringing mop, each element of which is found in the prior art, and the aggre-

* Such decision also appears in the advance sheets of the United States Patents Quarterly, vol. 99, page 306.

gation of these elements neither performs nor produces a new or different function or operation exceeding the sum of the functions or operations of the sum of the parts.

5. Rogers in his claimed aggregation sought to provide a self wringing mop using a sponge mopping element.

6. The specific combination claimed by Rogers, with all of its inherent alleged advantages is fully disclosed in the prior patent to Kawasaki No. 1,137,760 (R. 353) as may be seen from chart attached opposite page 14 wherein claims 7 and 10 are reproduced in comparison with Fig. 3 (and the other Figures) of the drawings of the Kawasaki prior art patent.

7. Respondents urged and the trial court found that "the key element in plaintiff's (Rogers) disclosure, (is) the rigid frame unit with the fixed spacing of the rollers." (R. 321) This is clearly disclosed in the Kawasaki prior art patent (Rec. 354, Col. 2, lines 91-98) as testified to by defendant's expert (R. 376).

8. The Court of Appeals in this case in rejecting, as the trial court did, petitioner's contention that Kawasaki disclosed the combination defined by claims 7 and 10 in suit, said (Rec. 382).

> "While the defendants at the trial introduced many prior art patents and publications in an attempt to show that the patent in suit was anticipated by the prior art, only five of such patents are relied upon in this court. However, we need mention only three, because they are asserted to be the most pertinent. They are Rogers No. 2,008,615, Kawasaki No. 1,137,-760, and Sanguinet No. 1,352,837, and much stress is laid upon the fact that these three patents were not

cited in the patent office. We have read the oral testimony, examined the documentary evidence and physical exhibits, and we are satisfied that the record supports the findings as made. Any doubt which we might entertain is dispelled by the keen analysis made by the District Court (Judge Perry) of the principles embodied in the patent in suit as well as the teachings of the prior art. We discern no reason to ignore the findings thus made, and certainly we cannot hold that they are clearly erroneous. Having thus concluded, no good purpose could be served by a detailed analysis either of the patent in suit or of the prior art relied upon to anticipate.

"Defendants' argument based on these prior art patents, not cited in the patent office, is not convincing. It has been held, and we think with logic, that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked. *Adler Sign Letter Co.* v. *Wagner Sign Service,* 112 F. 2d 264, 267; *Charles Peckat Mfg. Co.* v. *Jacobs,* 178 F. 2d 794, 802. • • •"

B.

Question Presented.

The decision of the Court of Appeals for the Seventh Circuit presents the following question:

1. Did the Court of Appeals in this case by its decision in holding claims 7 and 10 of the patent in suit valid and infringed depart from the test of invention as announced by decisions of this Court and depart from the well settled rule of law that the citation of more pertinent prior art than that cited by the Examiner destroys the presumption of validity?

C.

Reasons Relied Upon for the Allowance of the Writ.

The reasons relied upon for the allowance of the writ prayed for are:

1. In holding the patent in suit valid, the Court of Appeals for the Seventh Circuit has applied a test of invention which is contrary to the decisions of this Court as well as other Courts of Appeals and disregarded the rule that the citation of pertinent prior art not cited by the Examiner destroys the presumption of validity.

2. The question presented by this petition requires for its determination a pronouncement of what is a proper test of invention, and of the effect on the presumption of validity when pertinent prior art, not cited by the Examiner is called to the Court's attention, thereby constituting a question of great public importance for it not only affects the parties to this litigation but it also affects every member of the public, particularly those dealing or concerned with patents.

3. This question has long been troublesome and perplexing and arises without exception in every patent case in which the validity of the patent is put in issue.

Wherefore, it is respectfully submitted that the writ should issue.

Respectfully submitted,

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January 19, 1954.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No.

DAYLESS MANUFACTURING COMPANY, INC.
and LESLIE HOFFMAN,

Petitioners,

VS.

ARTMOORE COMPANY
and NILES METALCRAFT COMPANY,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The writ should issue to free the public of the unjust monopoly which the Court of Appeals has awarded to respondents by applying a test of invention contrary to that laid down in decisions of this Court.

I.

Opinions Below.

The opinion of the District Court is found in the record at page 316 and is reported in 109 F. Supp. 181, 96 U.S.P.Q. 254.

The opinion of the Court of Appeals is found in the record at page 379 and is reported in 99 U.S.P.Q. 306.

II.

Jurisdiction.

Jurisdiction is invoked under Sections 1254 (1) and 2101 (c) of Title 28 of the United States Code.

III.

Statement of Facts.

All of the facts necessary for consideration of the question raised in this case are stated in the accompanying petition for Writ of Certiorari, pages 1 to 5 herein.

IV.

Specification of Errors.

The Court of Appeals erred in sustaining the judgment of the Trial Court adjudging and decreeing claims 7 and 10 of the patent in suit valid.

V.

Argument.

In presenting this petition, your petitioners fully realize that many like petitions have been presented to this Court in the hope and expectation that some definite rule of law may be announced which will serve as a proper criteria of invention; or, that this Court will not hesitate to announce that its decisions in *Cuno Engineering Corp.* v. *Automatic Devices Corporation,* 314 U.S. 84, *Great Atlantic & Pacific Tea Co.* v. *Supermarket,* 340 U.S. 147 and *Crest Specialty* v. *Trager,* 341 U.S. 912 no longer state the test of invention but that the trier of each case shall formulate a test of invention according to the facts presented in such case.

The Court of Appeals for the Seventh Circuit has repeatedly rejected the "flash of genius" test of invention as announced by this Court in *Cuno Engineering* v. *Automatic Devices,* 314 U.S. 84.*

The Trial Court found that the only novel element in the combination covered by the two claims in suit is the frame unit with its rollers at opposite sides in fixed

* **Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.** 132 F. 2d 812, (C.A. 7, 1943); **National Slug Rejectors, Inc. v. A.B.T. Mfg. Co.** 164 F. (2d) 333, (C.A. 7, 1947); **Falkenberg v. Bernard Edward Co.** 175 F. 2d 427 (C.A. 7, 1949); **Peckat Mfg. Co. v. Jacobs,** 178 F. (2d) 794 (C.A. 7, 1949); **Barie v. Superior Tanning Co.** 182 F. 2d 724, (C.A. 7, 1950) where Judge Duffy speaking for the Court of Appeals for the Seventh Circuit said at page 727:

> "Plaintiff stresses that in its opinion the Trial Court quoted from **Cuno Engineering Corp. v. Automatic Devices Co.,** 314 U. S. 84, and included the portion containing the unfortunate 'flash of creative genius' phrase. This Court has twice specifically rejected the flash of genius test."

predetermined spaced relation (R. 319) and predicated invention upon its inclusion in an old combination. However this allegedly novel element is found in the Kawasaki prior art patent (R. 354, column 2, lines 92-98). This finding was adopted by the Court of Appeals without an independent appraisal of the prior art. In other words, both the Court of Appeals and the Trial Court in this case found the patent in suit valid despite the fact that every element of the claims in suit read squarely on the prior art Kawasaki patent, as shown in the chart attached opposite page 14, by the simple expedient of disregarding the prior art on the ground "that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked". This holding was reached notwithstanding the fact that the evidence in this case is uncontradicted that the Kawasaki prior art patent is more pertinent than any of the prior art patents cited by the Examiner (R. 209). The presumption of validity was treated as though it were conclusive and this pertinent prior art was completely disregarded. If the Court of Appeals had followed the test of invention as announced by this Court in the *Cuno* case, or in the *A & P* and *Crest Specialty* cases it could have arrived at no other conclusion than that invention over the Kawasaki patent (R. 353) is not spelled out by the two claims in issue. It is apparent also that the Court of Appeals disregarded the test of invention laid down by this Court in the *A & P* case. Just as in the *A & P* case invention was perceived by the lower courts in the addition of an element to an old combination although that element is taught by the prior art.

Just as in the *A & P* case the device covered by the claims performs the same function that the prior art device performs—it washes or cleans a dirty surface.

Just as the *A & P* three-sided rack does "just what any three-sided rack would do on any smooth surface" so the rollers of the mop covered by the claims in suit do what any rollers in a self-wringing mop do—wring or squeeze the mop. So also the rigid frame does what any such rigid frame unit did in the prior art—it mounts the rollers in fixed predetermined spaced relationship. The carrier unit does what any such prior art carrier did—it carries the mopping member. Just as the *A & P* "guide rails keep it from falling or sliding off the counter" so the mounting and reciprocating means (lever) do what any such means of the prior art do—they mount the units and effect the reciprocation of the units.

It is apparent that *Rogers* contributed nothing over the aggregate of the total of the old elements called for by the two claims in issue.

Is there a different criteria for invention among the several Circuit Courts of Appeals? In the language of the Court of Appeals for the Seventh Circuit in the case of *National Slug Rejectors, Inc.* v. *A.B.T. Manufacturing Corporation,* 164 F. 2d 812, is it the rule that

> "one court will reject what another accepts as patentable novelty, solely because of the difference in measuring standards"?

Is the presumption of validity to be given full weight despite the fact that the most pertinent prior art was not cited by the Examiner as was held by the Court of Appeals in this case or is the presumption of validity destroyed under such circumstances as was held by the

Court of Appeals for the Sixth Circuit in the very recent case of *Royal Patent Tool Corp.* v. *Monarch Tool & Mfg. Co.*, 97 U.S.P.Q. 196, 203 F. (2d) 299 (1953).

Is each of the ten Courts of Appeals to have its own test of invention or should this Court lay down a test of invention to be followed by all Courts of Appeals? That is the important question which these petitioners present to this Court for determination.

As the matter now stands among the several Courts of Appeals, if a manufacturer is sued for patent infringement in New York, he finds, from a survey of the decisions of the Court of Appeals for the Second Circuit* that the test of invention is as announced by this Court in the *Cuno* case, *supra,* to wit:

> "* * * the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling."

and from a survey of the decisions of the Circuit Court of Appeals for the Sixth Circuit** that when pertinent prior art not cited by the Examiner is called to the Court's attention "the presumption of validity does not exist."

On the other hand, if such manufacturer is sued in Chicago, he is informed from a reading of the decisions of the Court of Appeals for the Seventh Circuit that the

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* Weidhaas v. Loew's Inc., et al, 125 F. 2d 545 (C.A. 2). Other courts which have followed the Cuno case are as follows: Anderson Co. et al. v. Lion Products Co., Inc., et al., 127 F. 2d 454 (C.A. 1); Pearson Sanding Mach. Co. v. Williams Furniture Co., 132 F. 2d 55 (C.A. 4); Trabon Engineering Corp. v. Dirkes et al., 136 F. 2d 24 (C.A. 6); Freeman et al. v. Altvater et al., 138 F. 2d 854 (C.A. 8); Standard Cap & Seal Corp. v. Coe, 124 F. 2d 278 (App. D. C.); In re Shortell, 142 F. 2d 292 (C.C.P.A.).

** Royal Patent Tool Corp. v. Monarch Tool & Mfg. Co., 203 F. 2d 299, (1953).

test of invention is to the contrary. Indeed the test of invention as announced by this Court in the *Cuno* case is flatly rejected. As the Court of Appeals for the Seventh Circuit said in *Barie* v. *Superior Tanning Co.*, 182 F. 2d 727:

> "Plaintiff stresses that in its opinion the Trial Court quoted from *Cuno Engineering Corp.* v. *Automatic Devices Co.*, 314 U.S. 84 and included the portion containing the unfortunate 'flash of creative genius' phrase. This Court has twice specifically rejected the flash of genius test. *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812; *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427."

This illustrates in a small but effective way the sharp conflict between the several Courts of Appeals as to what is a proper test of invention and the weight to be accorded the presumption of validity when prior art not cited by the Examiner is called to the Court's attention.

There is no conflict of decisions with respect to the patent in suit. Petitioners frankly state that their hope of obtaining the allowance of their petition is based upon the great importance of the single question presented, as this question affects every manufacturer who seeks to determine whether a patent upon which a charge of infringement is based, spells out invention. It is as much to his interest to know the criteria of invention as it is to the patentee who asserts the charge of infringement.

CONCLUSION.

It as apparent from this brief survey of the law that the decision of the Seventh Circuit Court of Appeals is in apparent conflict with that of this Court, and in direct conflict with that of other Courts, on a question of importance in the law of patents. Wherefore, it is earnestly urged that the petition for a Writ of Certiorari be granted.

Respectfully submitted,

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MAURICE S. CAYNE,
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